III. REMARKS

Status of the Claims

Claims 1, 6-8, and 14 are amended and claims 5 and 13 are canceled. Claims 1-4,6-12,14, and 15 are presented for further consideration.

Summary of the Office Action

Claims 1-4, 6, 8, 10-12, stand rejected under 35USC102(b) on the basis of the cited reference Maeda (EP 0 156124 A2). Claims 5, 7, 13, and 15 stand rejected under 35USC103(a) based on the cited reference Maeda in view of Rignell, et al, U.S. Patent No. 5,818,920 ('920 patent). The Examiner is respectfully requested to reconsider his rejection in view of the above amendments and the following remarks.

Discussion of the Cited Reference

The Examiner has cited the reference Maeda in support of the rejection based on anticipation. The reference Maeda describes a system for accomplishing a purpose similar to that of the subject application, but it is accomplished in a different way. Maeda discloses that the local time difference information is read out from the memory unit (referred as 5) and the time information is read out from a clock unit (referred as 6) [column 3, lines 22-24]. The time difference in the system of Maeda is read out from the memory unit on the basis of the country code [column 4, lines 3-6]. There is also mentioned a specific time information storage area [column 4, lines 46-48]. Thus, the time difference determined according to Maeda, is calculated from the time information read from a clock and the time information read from memory. Time information of the receiver is stored in the memory

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with the name and number information. No network-relating solutions are mentioned in Maeda. In the present invention the caller usually does not know where the object of the call situates at the moment. Such movement of the object of the call is not taken into account in the solutions of Maeda. The cited reference Maeda, therefore, fails to support the rejection based on anticipation.

The Issue of Anticipation

It is well settled that a claim is anticipated, "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (See <u>CHISOLM</u>, Federal Circuit Guide, Pg. 1221).

The elements of the claim and their function and purpose within the claim must be reviewed in a manner similar to an infringement analysis. If the device described in the cited reference would not infringe if it was later, it will not anticipate if the reference is earlier.

Applying this standard to the system of the reference Maeda, it becomes clear that the system of Maeda is missing significant elements of independent claims 1 and 8. There is no provision in Maeda for transmitting the time parameter from the network Home Location Register. Since this element of the claims forms no part of the system of Maeda, there would be no infringement, if it was later, therefore, the cited reference does not support the rejection by the Examiner based on anticipation.

The Issue of Obviousness

The Examiner has further cited the '920 patent in support of the rejection based on obviousness. The '920 patent takes into account the fact that the receiver has forwarded calls to another

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terminal. In the '920 patent, the PSTN (Public Switched Telephone Network) determines the time zone of the called device. The time information is determined in the network, i.e. in PSTN or PLMN (Public Land Mobile Network). The Home Local Register for determining time zone information is disclosed (column 4, lines 54-56; column 7, lines 8-11]. However, in the system of the '920 patent, the time information is typically determined in the network (PSTN or PLMN), not in a terminal, as in the present invention. In the system of the '920 patent, the network requests confirmation for establishing the connection (column 7, lines 19, 22) and checks whether incoming calls are allowed to be connected or not [column 7, line 57]. So the solution is implemented in the network, whereas in the instant application the solution is implemented in calling device.

According to the present invention the received time information of the receiver (called) party is used for determining the time difference in the sending device. As is stated in the amended claim 1, a Home Location Register transmits the time parameter to the device setting up the call. In the present invention solution is implemented in the terminal device. Due to this difference in location for determining the actual time difference, the architecture of the network is totally different in these solutions, Also the implementations of the solutions are different in the network and in the terminals.

The '920 patent explains that subscriber A calls to subscriber B [e.g. in column 7, lines 28-29] and further states that B (i.e. receiver, or a called party) communicates to the network (PLMN) [column 7, lines 29-30]. In the present invention, the device of the caller determines the time difference.

The '920 patent discloses [column 8, lines 41-42, 47-48] that a

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filter unit may be built into a mobile phone. Such filter unit is used and programmed to handle incoming calls [column 8, line 17] i.e., calls directed to subscriber B, whereas in the present invention, a call to be established, i.e., the requested connection is checked in the caller's device (subscriber A according to the `920 patent).

The filter unit of `920 patent is programmed by the subscriber at terminal B [column 8, lines 29-30] and the party receiving a call can determine whether to receive the call or not. In the present invention, on the contrary, the calling party determines the time of a called party and decides whether the connection is established or not. The disclosure of the `920 patent, therefore, does not remedy the deficiencies described above with respect to the reference Maeda. The combination of teachings cited by the Examiner therefore, falls short of supporting the rejection based on obviousness.
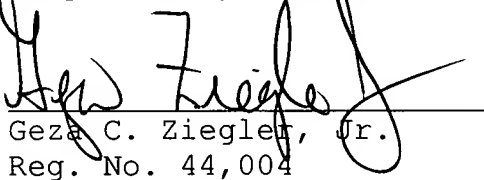
According to basic tenets of patent law, in order to support an obviousness rejection, there must be some suggestion of the desirability of making the modification, aside from the subject application. The claimed invention must be considered as a whole and the references must suggest the desirability and thus the obviousness of making the modification, the references must be viewed without the benefit of hindsight. (See MPEP sections 706.02(a) and 2141. Applicant submits that the modification of the teachings of the cited references in order to obtain the invention, as described in the amended claims submitted herein, would not have been obvious to one skilled in the art. There is no indication that such a modification would be desirable.

The above arguments are equally applicable to the rejected dependent claims.

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For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

A check in the amount of $980.00 is enclosed for a three month extension of time. The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

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4 October 2004
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